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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,920	07/25/2001	Toshio Asano	520.40381X00	9163

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EXAMINER	
PITTS, HAROLD I	
ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/889,920	ASANO ET AL
Examiner	**Group Art Unit**
HAROLD PATTS	2876

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 1/29/03.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 22-42 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 22-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Rejections will be based on the following criteria the criteria for applicant and/or counsel is ordinary skill in the art. i.e., a knowledge of all prior art including the ability to read, comprehend and to point out the claimed invention compared to the prior art concepts. The applicant is considered to have the pertinent prior art before him during conception and reduction to practice of the invention in light of this prior art including drafting the specification and claims. The applicant is considered to be aware that to merely substitute or additionally employ one or more teachings of one or more of the references before him in a combinational sense would clearly be within the purview of obviousness, the motivation being the skilled artisan's recognition of the interchangeable teachings of similar systems and the expedient of a substitutive or an additive employment of one or more prior art system concepts to provide a particular solution or to bring about a desired result.

35 USC 112 rejections:

a. The disclosure, like the claims must point out the invention. A disclosure in which the lexicography is unclear. Vague, convoluted or incomplete does not comply with the statute.

b. A disclosure which merely discusses prior art concepts without really setting a forth on independently arrived at enabling disclosure does not comply.

c. Claims based on a disclosure as above or are vague, incomplete or merely expressions or desired results do not comply with the statute.

35 USC 103 rejections and motivation.

The criteria here is a skilled artisan who is looking first to the prior art for aid in the conception and reduction to practice phase of inventing and who is technologically skilled in the research of patent and other documentation and in the employment of prior art concepts in substitutive and additive combinations to address and implement a system, having collected and subjected the pertinent prior art (such as cited here in) and viewing the prior art technique of employing the desired inventive concepts in or more combinations to provide successfully similar solutions and which considered in combination address applicant's essential inventive concept, would find in such an addressing the "suggestion" or suggestions" or "motivation" that the prior art concepts might be successfully employed in combination as set forth in applicant's claims.

35 USC 102 rejections:

A rejection under 35 USC 102 indicates that the claims, drafted in light of one or more references, fail to point and distinctly claim any discernible novel essential inventive concept.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-42 are subject tp the same rejections as set forth previously. As part of applicant's disclosure requirement it is necessary to point out the invention in view of the prior art which in this instance is the art cited and applied in detail in the PCT to claims of essentially the same subject matter and scope as 22-42. Also the independent claims appear to be drawn to different inventions. to be responsive, each independent claim must be argued as to unity of invention and the novel/unobvious language in view of Sauverwein (which has a ~~rior~~ prior page U.S. equivalent) and the other IDS references pointed out.

Harold Pitts

703-308-0717

Harold Y. Pitts
Primary Examiner

Pitts/ek

04/18/03